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second audio scaling devices (34 and 22). The primary reference is said to not disclose that the audio system could be used within a vehicle, a second directional audio channel source (signal from 11-11n, which is input to 22).

The secondary reference is said to disclose an audio system which is comprised of first transducers situated behind a first passenger location and for transmitting a first directional audio signals (RW and LW), a second transducers situated forward of the first transducers and for transmitting the first directional audio signals (RF and LF), and a third electroacoustical transducer for transmitting rear signals (RR and RL). Since the secondary reference is said to have disclosed a speaker system which could be used within a vehicle, it is said it would have been obvious to combine the secondary reference teaching with the primary reference because a speaker system of the primary reference it is said could be used within a vehicle for reproducing enhanced acoustic image.

Regarding claim 4, the primary reference as modified are said to not disclose a second directional audio channel source is a center channel source. However, even though the primary reference as modified do not disclose a second directional audio channel source being a center channel source, it is said it would have been obvious to have a center channel source as claimed because it is said reproducing a center sound in an audio system is said to be well known in the art.

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of

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making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembicza*k]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

The claims call for an audio system for a vehicle, a first passenger location and a second passenger location, said second passenger location situated behind the first passenger location. The primary reference discloses an audio reproducing apparatus that sends audio signals to two

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different rooms. The primary reference does not disclose passenger locations, let alone a second passenger location situated behind a first passenger location, nor an audio system for a vehicle.

The claims also call for a first electroacoustical transducer coupled to the first directional audio source and to the surround audio channel source. The office action states that elements 11-1-11-n correspond to a first directional audio channel source, that surround circuit 33 corresponds to the surround audio channel signal source, and that elements 39L and 39R correspond to the recited first electroacoustical transducer.

The path of surround circuit 33 in the primary reference and inputs for signals 11-1-11-n are coupled to elements through binary switch 32. Since the switch is binary, elements 22 and the inputs for signals 11-1-11-n, element 22 OR the inputs for 11-1-11-n could be coupled to elements 39L and 39R. Elements 22 AND the inputs for 11-1-11-n cannot be coupled to elements 39L and 39R.

Furthermore, element 11-1-11-n cannot be coupled to elements 39L and 39R at all. At column 3, lines 21-28, the primary reference discloses that, "the switch 31 is ganged with the switch circuit 32 in a manner that when the movable contact of the switch circuit 31 is changed over to the stationary contact of the variable resistor 34 side, in case of the reproduction of the surround stereo sound, the movable contact of the switch circuit 32 is changed over to the stationary contact of the output terminal 36 side." So with the switch 31 in the position shown in FIGS. 1A and 1B, element 22 is not coupled to elements 39L and 39R. With the switches in the other position (so that the movable contact of switch 31 is coupled to element 22, the movable contact of switch 32 is on the side of a circuit portion that does not include elements 39L and 39R. Thus, element 22 cannot be coupled to elements 39L and 39R.

The Polk secondary reference does not overcome the shortcomings of the primary reference. The secondary reference does not disclose a second passenger location behind a first passenger location. The secondary reference does not disclose a first electroacoustical transducer coupled to a first audio source and a surround audio channel source. Speakers LW and RW are coupled to only one directional audio channel source, the source L channel and the R channel, respectively.

It is thus impossible to combine the primary and secondary references to form the subject matter of the rejected claims.

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"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). That is reason enough for withdrawing the rejection of claims on the primary and secondary references.

Furthermore, there is nothing in the primary and secondary references to suggest the desirability of combining what is there disclosed to meet the terms of the rejected claims. Nothing in the references suggests an audio signal for reproducing an enhanced stereo image in a vehicle. The primary reference discloses audio reproducing apparatus that is capable of supplying audio signals of different program sources to a plurality of speaker output terminals and further capable of adjusting the volume of the audio signal supplied to the output terminals independently.

Accordingly, withdrawal of the rejection of claims 1-9 as unpatentable over the primary reference in view of the secondary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to elements in the rejected claims, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the rejected claims.

3. The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are submitted of being incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to

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telephone the undersigned attorney at (617) 521-7014 to discuss what steps he believes are necessary to place the application in condition for allowance.

No fees are believed to be due; however, the Commissioner is respectfully requested to apply any charges or credits to Deposit Account No. 06-1050, Order No. 02103-399001.

Respectfully submitted,

FISH & RICHARDSON P.C.

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